

## **REMARKS/ARGUMENTS**

### **35 U.S.C. §112, second paragraph Rejection: Claim 17**

Claim 17 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 has been amended to broaden the claim by removing the claim 13 limitation requiring the first, second, and third bat portions to be bonded to one another. Based on such amendment it is respectfully submitted that claim 17 is now in condition for allowance.

### **35 U.S.C. §102, Anticipation Rejection: Claims 1-4, 6, 7, 13-16, and 18**

Claims 1-4, 6, 7, 13-16, and 18 stand rejected under 35 U.S.C. §102 as being anticipated by Bender et al. 6,007,440.

Before setting forth a discussion of the prior art patent applied in the Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under Section 102, including the following citations. "For a prior art reference to anticipate in terms of 35 U.S.C Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed Cir, 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986). Anticipation under 35 U.S.C. Section 102 requires that there by an identity of invention. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, \_\_\_, 225 U.S.P.Q. 635, 637 (Fed. Cir. 1985).

Independent claims 1 and 13 have been amended by adding a limitation requiring the claim 1 and 13 inventions to be constructed using at least two different types of material. As noted in the Applicants' specification, different materials naturally have different densities. For example, if one constructs a bat having a plurality of bat portions, where the bat portions are composed of different materials, such bat portions will naturally have different densities yielding a bat of non-uniform density. Thus, the Applicants' invention allows one to construct a bat having a non-uniform density without the need for testing the material used to construct such a bat.

In contrast, Bender et al. teaches a laminated bat composed of a single type of wood. Indeed, Bender et al. teaches the following: "The preferred wood to be used is a select grade of white ash"<sup>1</sup>. Since no wood is perfectly uniform in its physical properties, Bender et al. teaches that a particular piece of wood may be tested to determine the sections of such wood that have superior physical characteristics of interest for a particular purpose. Bender et al. teaches non-destructive testing<sup>2</sup> of wood laminas so that the laminas can be "graded according to some indicator of quality, such as density."<sup>3</sup> To construct a bat having varying density, Bender et al. teaches constructing different portions of the bat with different grades of a particular type of wood. Bender et al. does not teach or suggest using different types of wood. Indeed, it is respectfully submitted, that such Bender et al. teachings are in stark contrast to the Applicants' inventions and actually teach away from, and highlights the novelty of, the Applicants' inventions.

As to claims 2-4, 6, 7, 14-16, and 18, such claims depend directly or indirectly from either independent claim 1 or 13 and only add further patentably distinguishable features to such inventions.

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<sup>1</sup> See Bender et al. 6,007,440 at C3, L54-55.

<sup>2</sup> Id. at C1, L20-24; C3, L47-50,

<sup>3</sup> Id. at C4, L1-4.

Based on the above statements, Applicants respectfully traverse the above identified §102 rejection and submit that claims 1-4, 6, 7, 13-16, and 18 are in condition for allowance.

**35 U.S.C. §103, Obviousness Rejection**

Claims 5 and 17 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Cook 4,714,251. Claims 8 and 21 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Winterowd et al. 5,944,938. Claims 9, 10, 22, and 23 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of Burns et al. 6,506,823. Claims 11, 19, 20, and 24 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440. Claims 12 and 25 stand rejected under 35 U.S.C. §103 as being unpatentable over Bender et al. 6,007,440 in view of You 4,572,508.

As noted above, independent claims 1 and 13 have been amended by adding a limitation requiring the claim 1 and 13 inventions to be constructed of at least two different types of material; a feature not found in the base reference Bender et al. '440. It is respectfully submitted that none of the remaining references cited in the Office Action cure such deficiency in the base reference Bender et al. '440. Therefore, Applicants respectfully submit that none of the cited combinations teach each and every element of either claim 1 or claim 13. As to the remaining claims that depend from either claim 1 or claim 13, such dependent claims only add further patentably distinguishable features to the claim 1 and 13 inventions. For at least these reasons, it is respectfully submitted that such claims are in condition for allowance.

Additionally, as is well known, “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.”<sup>4</sup> (emphasis original) Indeed, “virtually all

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<sup>4</sup> Graham v. John Deere Co., 381 U.S. 1, 148 U.S.P.Q. 459 (S. Ct. 1966)

inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior patents would necessarily destroy virtually all patents and cannot be the law under the statute, '103.'<sup>5</sup>

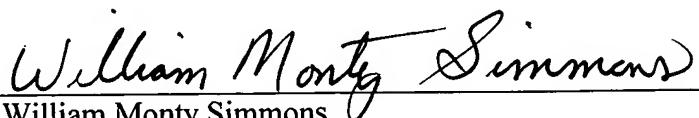
Consequently, "the task of the Patent Office is essentially a burden of proof not just to show prior patents with selected elements similar to respective parts of a claimed combination, but to show teachings to support obviously combining the elements in the manner claimed."<sup>6</sup> "[S]implicity and hindsight are not proper criteria for resolving the issue of obviousness."<sup>7</sup>

It has been respectfully submitted that Bender et al. teaches away from the Applicants' invention. In addition, it has been respectfully submitted that none of the secondary references suggest nor do they provide motivation to combine the teachings of the various secondary references with the Bender et al. teachings to achieve the Applicants' claim 1 and 13 inventions. It is respectfully submitted, therefore, that none of the cited secondary references overcome the above identified deficiency in the base reference. The remaining depend claims simply add further patentably distinguishable features to the claim 1 and 13 inventions. For at least these reasons, Applicants respectfully traverse the above identified 103 rejections and submit that the rejected claims are in condition for allowance.

Therefore, applicants respectfully request favorable action and withdrawal of the present rejections. The Examiner is invited to call the undersigned at his convenience to resolve any remaining issues. Please charge any additional fees required by this Amendment to Deposit Account No. 503176.

Respectfully submitted,

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Date

  
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<sup>5</sup> Panduit Corp. v. Dennison Manufacturing Co., 1 U.S.P.Q. 2d 1593, 1603 (Fed. Cir. 1987; footnotes omitted).

<sup>6</sup> ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

<sup>7</sup> Ex parte Clapp, 227 U.S.P.Q. 972, 973 (PTO Bd. App. 1985).